

REMARKS

Applicant has cancelled claims 2 and 15-28. Applicant herein adds new claims 32-34. Applicant also withdraws claim 29 without prejudice, as directed to the species of Group V. Applicant also herein amends claims 1, 3 and 31. Claims 12, 26 and 30 were previously withdrawn.

In the Office Action, the Examiner noted the listing of references in the specification, commenting that such a listing does not comprise a proper information disclosure statement. Applicant has included an information disclosure statement with this response, along with the appropriate fee.

The Examiner also objected to the specification as including embedded hyperlinks. The specification is herein amended to remove embedded hyperlinks.

The Examiner rejected claims 1 and 31 under 35 U.S.C. §102(b) as anticipated by Japanese Patent No. JP 2001-78874, and U.S. Patent No. D486377 to *Kelleghan*. As applicant has amended claims 1 and 31 to include the features of claim 2. Applicant contends these rejections are now overcome. While making these amendments to claims 1 and 31, applicant expressly states that it does not agree with the Examiner's §102(b) rejections, reserving the right to pursue these claims in a future continuation application.

The Examiner has rejected claims 2 and 3 under 35 U.S.C. §103(a) as being unpatentable over either one of JP 2001-78874 or *Kelleghan* each taken in view of U.S. Patent No. 6,247,730 to *Henderson, et al.* and U.S. Patent No. 4,815,999 to *Ayon, et al.* While claim 2 has been cancelled, since the disclosure of claim 2 has been added to amended claim 1, an analysis of this rejection is still required.

Neither JP 2001-78874 or *Kelleghan*, disclose or teach a figurine with a body having a substantially hollow interior and

a door for access to this interior. This is supported by the Examiner's own admission that neither reference discloses a door. See Office Action, page 4, lines 21-22.

Henderson, et al. is to a book having two covers which are joined together, such as by a zip fastener 16, also disclosing a conventional lanyard clip 20 attached by a ring 22 to the zip slider 24. The Examiner states that "*Henderson, et al.* (figures 1, 2) teaches ... a facial body 12 with a mouth 16 that can be opened and closed to store an item." See Office Action, page 4, lines 23-24.

Ayon, et al. discloses an insulated container having an exterior three-dimensional caricature. The Examiner points out that *Ayon, et al.* teaches "a door 50 hinged 54 so that items can be placed in the body of the figurine." See Office Action, page 5, line 3.

The Examiner states that "it would have been obvious to modify the figurines of either JP 2001-78874 or *Kelleghan* so as to place a door in the figurine for storing items therein in view of *Henderson, et al.* ... and *Ayon, et al.*" See Office Action, page 5, lines 5-9. Applicant respectfully disagrees.

First, to set forth a *prima facie* case of obviousness over a combination of references, the examiner must show that the prior art provides some suggestion or motivation to combine the references, i.e., the prior art must teach or suggest the desirability of the combination. M.P.E.P. §2143.01.

No reference or suggestion is made in the JP 2001-78874 or *Kelleghan* to use their respective figurines to provide internal storage, such as by providing a substantially hollow interior of the body with a selectively openable door assembly including a hinge assembly, as in claims 2 and 3 of the present invention. The devices depicted in both JP 2001-78874 and *Kelleghan* differ in fundamental design from the devices of both *Henderson, et al.*

and Ayon, et al. In fact, applicant finds it quite astounding that the Examiner would suggest that just because there exists things like change purses (arguably the *Henderson* reference), and beverage steins with tops (Ayon, et al.), that the existence of those everyday items could somehow suggest a relationship to the clearly un-openable dolphin of *Kelleghan* and the equally un-openable toy figure of JP 2001-78874.

JP 2001-78874 and *Kelleghan* depict keychain-like carabiners, with nothing to suggest real or potential improvement by combination with *Henderson, et al.*'s book cover or Ayon, et al.'s beverage stein. Accordingly, it is apparent that the Examiner is relying upon personal knowledge or impermissible hindsight to supply the missing suggestion or motivation to combine the references. If the Examiner is relying on personal knowledge, Applicant requests that the Examiner provide an affidavit or declaration setting forth specific factual statements and an explanation to support his findings, in accordance with M.P.E.P. § 2144.04(C). Otherwise, reliance on Applicant's own disclosure to provide a basis to combine references is improper hindsight reconstruction. See M.P.E.P. § 2145(X)(A). Thus, lacking any suggestion or motivation within the references to make any of the combinations sought by the Examiner, the rejection of claims 2 and 3 should be withdrawn.

Second, the Examiner may not rely on a modification of a primary reference to set forth a *prima facie* case of obviousness if the modification would change the principle of operation of the primary reference being modified. See M.P.E.P. §2143.01. Thus, if "the suggested combination of references would require substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference's] construction was

designed to operate," then this combination of references is not sufficient to render the claims at issue *prima facie* obvious. *Id.*

In making the cited combinations, the Examiner is modifying the basic principle of operation of the devices depicted in JP 2001-78874 and *Kelleghan*. The JP 2001-78874 device appears to be a keychain attached to a human figurine. Modification of JP 2001-78874's keychain with *Henderson, et al.*'s book cover would fundamentally change the basic principle under which the keychain's construction was designed to operate. Similarly, modifying JP 2001-78874's keychain with *Ayon, et al.*'s insulated container would also fundamentally change the keychain's operating principle. Thus, either modification would change the basic principle under which JP 2001-78874's keychain device was designed to operate.

Moreover, with respect to *Kelleghan*'s dolphin figurine, modification as suggested by the Examiner would fundamentally change the basic principle of operation of *Kelleghan*'s device even more drastically than the change engendered with the JP 2001-78874 keychain device. *Kelleghan*'s device, in all embodiments, is depicted as a life-like depiction of a dolphin. The addition of an insulated container as in *Ayon, et al.*, or of a book cover, as in *Henderson, et al.*, would not only clearly alter the fundamental operating principles of *Kelleghan*'s device, but would destroy the advantageous profile of the device, which would be disadvantageous.

Third, even if the above combinations were made, the resulting device would still not disclose all the features of the rejected claims. For example, any combination of JP 2001-78874 or *Kelleghan* with *Henderson, et al.* would not disclose a head portion and a body portion, with the body portion having a substantially hollow interior. *Henderson, et al.* does not teach

a body portion, merely a head portion. Any combination with Henderson would thus place the hollow interior within the head portion, which is not as in the rejected claims.

Likewise, any combination of JP 2001-78874 or *Kelleghan* with *Ayon, et al.* would not disclose a hinged door on the body, as the only depiction of a door in *Ayon, et al.* is on the head of the caricature on the insulated container.

On the basis of the foregoing, the Applicant respectfully maintains that the Examiner has not set forth a prima facie case of obviousness with respect to claims 2 and 3. Therefore, the rejection of these claims is improper and should be withdrawn.

The Examiner has further rejected claims 4-9 and 11 under U.S.C. §103(a) as being unpatentable over either one of JP 2001-78874 or *Kelleghan* each taken in view of *Henderson, et al.* and further in view of JP 10-118340.

JP 10-118340 depicts a doll figurine having a chest cavity with a hinged door that opens from the top. Regarding claims 4-9, the Examiner states that JP 10-118340 teaches a standing figurine at figure 1a and 2. As to claims 5, 6 and 11, the Examiner states that JP 10-118340 includes a door in the body of the figurine and that it would have therefore been obvious to modify the figurines of either JP 2001-78874 or *Kelleghan* so that the door suggested by *Ayon, et al.* is in the body for easier access. Applicant respectfully disagrees.

Referring to figures 1a and 2 of JP 10-118340, Applicant notes that figure 1a merely shows the figurine with legs extended, whereas figure 2 clearly does not show "a standing doll". Moreover, there is no descriptive text indicating that the figurine of JP 10-118340 can stand, or that this would even be desirable. Therefore, rejection of these claims on this basis is improper and should be withdrawn.

As noted above, modifying the JP 2001-78874 or *Kelleghan* devices with selected features from *Ayon, et al.* is not a proper combination in the first place. Thus, further modification of a device of these improper combinations with a feature from JP 10-118340 is also improper.

Moreover, all the arguments with reference to the suggested combinations of either JP 2001-78874 or *Kelleghan* with either *Henderson, et al.* or *Ayon, et al.* also apply with respect to JP 10-118340. That is, there is no motivation or suggestion within the references for such a combination and the basic principles of operation of the JP 2001-78874 or *Kelleghan* devices would change if the modifications were made. Lacking any motivation or suggestion for combination from the references, the Examiner must be using hindsight to guide his choice of features to combine from the various references. Such use of hindsight is not permissible. See M.P.E.P. § 2145(X)(A). Thus, rejection of claims 5, 6 and 11 should therefore be withdrawn.

Applicant has added claims 32-34 to particularly point out the standing feature of an aspect of the invention, as originally claimed in claim 4. Claim 4 has been amended to depend from amended claim 1. New claims 32-34 are fully supported by the specification. Moreover, the above arguments regarding claims 4-9 are also applicable to new claims 32-34, i.e., claims 32-34 are not rendered obvious by any combination with JP 10-118340.

As to claims 7-9, the Examiner again relies on the improper combination of the JP 2001-78874 or *Kelleghan* devices with selected features from *Ayon, et al.* and JP 2001-78874, stating "placement of the head at the top of the door is an aesthetic choice over stopping of the door below the head of the doll as taught by JP 10-118340 and as an aesthetic choice it lacks any

utility and is obvious over the teachings of JP 10-118340." See Office Action, page 6, lines 2-5.

Again, there is no motivation or suggestion within the references themselves for such a combination. Such motivation or suggestion is thus the result of the Examiner looking at the present invention and then seeking combinations that cover all its features. Again, this is impermissible hindsight. See M.P.E.P. § 2145(X)(A). Thus, rejection of claims 7-9 should be withdrawn.

Applicant notes that beyond the rejections based on the impermissible combinations described above, the Examiner has absolutely no support for rejecting claims 6-9.

The Examiner also rejected claims 13 and 14 under U.S.C. §103(a) as being unpatentable over either one of JP 2001-78874 or *Kelleghan* each taken in view of U.S. Patent No. 3,563,430 to *Forrest*. *Forrest* is drawn to a "carrier for articles such as pitons," and includes figures showing some details of a carabiner.

While admitting that neither JP 2001-78874 nor *Kelleghan* disclose use of either a pivoted gate or resilient gate for the construction of the carabiner gate, the Examiner states that *Forrest* teaches both types of gate, and that it would have been obvious to use *Forrest's* carabiner gate in either the JP 2001-78874 or *Kelleghan* device. Applicant again respectfully disagrees.

Neither JP 2001-78874 nor *Kelleghan* provides any motivation or suggestion for combination with *Forrest*, nor does *Forrest* provide such motivation or suggestion for combination. Once again, the complete lack of a motivation to combine these references within the references themselves clearly suggests that such motivation can only have arisen due to impermissible hindsight on the part of the Examiner. See M.P.E.P. §

2145(X)(A). For this reason, the rejection of claims 13 and 14 should also be withdrawn.

Applicant notes that the Examiner has indicated that claim 10 would be allowed if rewritten in independent form. Applicant believes the rejections of all claims upon which claim 10 depends have now been overcome, thus obviating a need to rewrite claim 10 in independent form.

As it is believed that all of the rejections set forth in the Office Action have been overcome by the amendments and remarks herein, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such can be taken at this time, it is respectfully requested that he/she telephone applicant's attorney at (732) 634-7634 in order to overcome any additional objections which he might have.

Applicant does not believe any fees are due with this Amendment. However, in the event there are any fees due and owing in connection with this matter, please charge same to our Deposit Account No. 11-0223.

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Respectfully submitted,

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